

a2 displaying the selected product image includes the step of integrating a product image with a background image to provide a customized product image on the display.

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a3 11. (Amended) The apparatus of claim 10, wherein the means for displaying a plurality of product images includes means for displaying a scroll box on the display which includes the plurality of product images from a selected product category.

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a4 17. (Amended) The apparatus of claim 10, wherein the plurality of product images includes at least one product image and at least one background image, and the means for displaying the selected product image includes means for integrating a product image with a background image to provide a customized product image on the display.

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a5 20. (Amended) The apparatus of claim 19, wherein the selected product image and the selected background image are integrated by the integrating means based on a map transmitted to the computer from a vendor's computer located at a remote location.

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#### REMARKS

Applicant has filed, contemporaneously herewith, a terminal disclaimer to overcome the obviousness-type double patenting rejection of claims 8, 9 and 17-20 in view of U.S. Patent No. 5,970,471. Applicant has amended claims 2, 8, 11, 17 and 20 for the sole purpose of overcoming the Examiner's rejections under 35 U.S.C. § 112, second paragraph. Applicant believes that these amendments do not narrow the scope of the claims.

Applicant believes that the § 112 rejections of claims 9 and 18 are overcome by the amendments to claims 8 and 17, respectively, from which they depend. Applicant submits that the Examiner's rejections under 35 U.S.C. § 112, second paragraph, are overcome by these amendments.

Independent claims 1, 10, and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wiecha (5,870,717) in view of Cameron et al. (5,592,378). Applicant respectfully traverses the Examiner's rejections under 35 U.S.C. § 103(a).

Applicant does not admit that Wiecha qualifies as prior art. Applicant reserves the right to file a Declaration under Rule 131 to remove Wiecha as a reference.

However, Applicant submits that the Examiner's rejections are improper because, as discussed below, neither Wiecha nor Cameron et al., alone or in combination, discloses, teaches or suggests all of the limitations of claims 1, 10, and 19.

In order to establish a *prima facie* case of obviousness, the cited references must teach or suggest all of the claim limitations. Manual of Patent Examination Procedure (8<sup>th</sup> ed., Aug. 2001) ("MPEP") § 2143 at 2100-122. "All the claim limitations must be taught or suggested by the prior art." MPEP §2143.03, at 2100-126 (citing In re Royka, 490 F.2d 981 (CCPA 1974) (emphasis added)). "In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." MPEP §2141.02, at 2100-118 (citing Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530 (Fed. Cir. 1983); Schenck v. Nortron Corp., 713 F.2d 782 (Fed. Cir. 1983)) (emphasis in original).

"There must be a teaching or suggestion within the prior art, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources of information, to select particular elements, and to combine them in the way they were combined by the inventor." ATD Corp. v. Lydall Inc., 48 USPQ2d 1321, 1329 (Fed. Cir. 1998).

Wiecha relates to a system for ordering items over a computer network using an electronic catalog. Wiecha does mention that "where similar items are available, a "Compare" icon can be selected on the screen, causing the items to be listed side by side, with differences highlighted." (emphasis added). Wiecha provides no disclosure or suggestion of how the

“Compare” icon works. By using the word “listed”, it appears that Wiecha only refers to the text, and not the pictures. Wiecha uses the term “displayed” when discussing pictures in Column 3, lines 19 and 20. This is consistent with the last two lines in Column 8 of Wiecha which state that varying features of the text are highlighted. Wiecha does not disclose, teach, or suggest displaying product images in review boxes for side-by-side comparison, as recited in independent claims 1 and 10, let alone the specific features recited in the dependent claims.

Cameron et al. teaches displaying source catalog cover pages (Fig. 18; col. 13 lines 57-67) and displaying pages of a catalog sequentially (Fig. 19; col. 14 lines 26-60). Cameron et al. does not disclose or suggest displaying selected product images in review boxes for side by side comparison as claimed in independent claims 1 and 10, let alone the specific features recited in the dependent claims.

Therefore, Cameron et al. does not make up for the deficiencies of Wiecha. For at least these reasons, Applicant submits that independent claims 1 and 10 patentably define the invention over the combination of Wiecha and Cameron et al.

Neither Wiecha nor Cameron et al. discloses, teaches, or suggests integrating a selected product image with a selected background image, as recited in independent claim 19.

Independent claim 19 was also rejected under 35 U.S.C. § 103(a) as being unpatentable over Wiecha in view of Mizokawa (U.S. 4,530,009). Applicant respectfully traverses the Examiner’s rejections under 35 U.S.C. § 103(a).

As admitted by the Examiner, “Wiecha does not specifically teach a means for integrating the selected product image with the selected background image on the display to provide a customized product image on the display.” (Office Action, para. 14).

Mizokawa discloses an image synthesizing unit which mixes video signals. Col. 3 lines 34-38. In Mizokawa, the foreground picture varies continuously during the display (Col. 2 lines 65-66; col. 4 lines 16-17), and the background picture is shot with a video camera (Col. 4 lines 5-6). Thus, Mizokawa is completely unrelated to the invention of claim 19. Mizokawa does not disclose, teach or suggest “means for integrating the selected product image with the selected

background image in the display to provide a customized product image on the display” as particularly recited in independent claim 19.

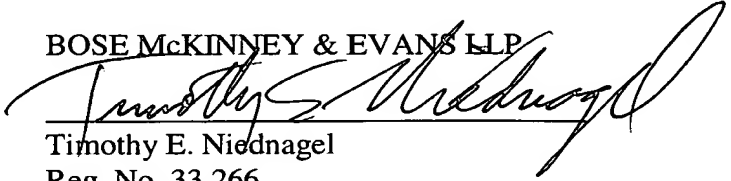
When combining the content of various references, “there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant.” In re Dance, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); In re Raynes, 28 USPQ2d 1630, 1631 (Fed. Cir. 1993); In re Oetiker, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). “The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.” In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Accord, In re Fritch, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). “Obviousness can not be established by hindsight combination to produce the claimed invention.” In re Dance, 48 USPQ2d at 1637; In re Gorman, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). “Determination of obviousness can not be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention. There must be a teaching or suggestion within the prior art, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources of information, to select particular elements, and to combine them in the way they were combined by the inventor.” ATD Corp. v. Lydall Inc., 48 USPQ2d 1321, 1329 (Fed. Cir. 1998).

There is no such motivation to combine Mizokawa with Wiecha to produce the present claimed invention. For at least these reasons, Applicant submits that independent claim 19 patentably defines the invention over the combination of Wiecha and Mizokawa.

For at least all of the above reasons, none of the prior art of record discloses, teaches or suggests Applicant’s invention as particularly recited in claims 1-20. Accordingly, Applicant respectfully requests that all of the Examiner issue a Notice of Allowance in due course.

Respectfully submitted,

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## APPENDIX A

### In the Claims

Please amend claims 2, 8, 11, 17 and 20 as follows:

2. (Amended) The method of claim 1, wherein the step of displaying a plurality of product images includes the step of displaying a scroll box on the display which includes the plurality of product images from [the] a selected product category.

8. (Amended) The method of claim 1, wherein the plurality of product images [include both a] includes at least one product image and [a selected] at least one background image, and the step of displaying the selected product image includes the step of integrating [the] a product image with a [selected] background image to provide a customized product image on the display.

11. (Amended) The apparatus of claim 10, wherein the means for displaying a plurality of product images includes means for displaying a scroll box on the display which includes the plurality of product images from [the] a selected product category.

17. (Amended) The apparatus of claim 10, wherein the plurality of product images [include both a] includes at least one product image and [a selected] at least one background image, and the means for displaying the selected product image includes means for integrating [the] a product image with a [selected] background image to provide a customized product image on the display.

20. (Amended) The apparatus of claim 19, wherein the selected product image and the selected background image are integrated by the integrating means based on a map transmitted to the computer from a vendor's computer located at a remote location.

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